

REMARKS

Applicant gratefully acknowledges the telephonic interview with the Examiner and SPE conducted on January 20, 2004. Applicant has attempted to address the issues raised by the Examiner and SPE in the interview with this response.

Applicant has studied the Office Action dated November 19, 2003, and has made amendments to the claims. Claims 17 and 20 have been amended. The amendment to claim 20 was to correct a typographical error and is not related to patentability. Claims 1-20 are pending. Claims 1, 9, 12, 15 and 20 are independent claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to Specification

Amendments have been made to the specification at page 1 to claim foreign priority and to pages 9, 13, 16 and 25 to correct typographical errors. No new matter has been added as the amendments have support in the application as originally filed.

Claim for Foreign Priority Under 35 U.S.C. § 119

In the Office action, the Examiner acknowledged the Applicant's claim for foreign priority under 35 U.S.C. § 119 and the receipt of the certified copy of the priority document. However, the Examiner indicated that the certified copy had been filed in "parent Application No. 14245/2000," which is the priority document. Therefore, to avoid any confusion, Applicant has attached a certified copy of the priority document hereto. Applicant has also amended the specification to claim priority under 35 U.S.C. § 119(a) to Korean Application No. 14245/2000, filed on March 21, 2001.

Objections

The Examiner objected to informalities in the specification and claims. Specifically, the Examiner suggested changing "second" to "first" on line 9 of the Abstract on page 25, changing "explanation" to "explanatation" on line 13 of page 9, changing "502" to "501" on line 3 of page 13, changing "he" to "the" on line 9 of page 16, and changing "cobination" to "combination" in claim 20 at line 13 of page 24. With this paper, the specification and claim have been amended as suggested by the Examiner. Applicant respectfully requests that the objections be withdrawn.

§112 Rejection

The Examiner rejected claim 17 under 35 U.S.C. § 112, first paragraph, as not being supported by either a substantial asserted utility or a well-established utility and, therefore, asserted that one skilled in the art clearly would not know how to use the claimed invention. Specifically, the Examiner asserted that the recitation of a magnetic circuit "beyond the magnetic path for the associated magnetic circuit unit" is considered an undesirable characteristic of magnetic circuits. With this paper, claim 17 has been amended to recite that the magnetic paths for the magnetic circuit units are "present in the same space." Support for the amendment can be found in the specification at page 17, ll. 9-12. Applicant respectfully submits that the grounds for the rejection have been overcome and requests that the rejection be withdrawn.

§ 102 Rejection

Claims 1-16, 18 and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nagasato (US 6,181,670). This rejection is respectfully traversed.

A proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

Independent claim 1 recites a lens holder attached with coils and magnets mounted to the lens holder as well as a fixed body having a magnet and coils mounted thereon. The Examiner asserts, on page 4 of the Office action, that Nagasato, at col. 8, ll. 22-34 and Figure 1, discloses all the elements of claim 1.

It was respectfully noted in the telephonic interview conducted on January 20, 2003 that Nagasato, at col. 8, ll. 29-33, discloses "driving coil assemblies 112 and 114 [and] magnets 116 and 118" and, at col. 8, ll. 59-68; discloses that coil assemblies 112 and 114 each have "a focusing coil, a tracking coil, a radial tilt coil and a tangential tilt coil" and, at col. 9, ll. 30-42, discloses that "driving coil assemblies 112 and 114 are connected to the support block." The Examiner and SPE apparently agreed.

It was respectfully submitted in the interview that the portion of Nagasato cited by the Examiner does not disclose a lens holder having any coils, but rather a lens holder having only "magnets 116 and 118" attached thereto and all the coils are disclosed in the "driving coil

assemblies 112 and 114" which are "connected to the support block," or in other words, all the coils disclosed in Nagasato are mounted to the fixed body (support block). The Examiner and SPE apparently agreed.

Furthermore, it was respectfully submitted in the interview that no other portion of Nagasato discloses or suggests a lens holder having a magnet and coils mounted thereon and a fixed body having a magnet and coils mounted thereon. The Examiner and SPE apparently agreed.

It is respectfully asserted that independent claim 1 is allowable over the cited reference. It is further respectfully asserted that claims 2-8, which depend from claim 1, are also allowable over the cited reference.

Independent claims 9, 12, and 15 all recite a combination of a moving magnet system and a moving coil system. The Examiner asserts, on page 5 of the Office action, that the combination of col. 11, line 45 through col. 12, line 40 and Figure 7 of Nagasato and col. 16, ll. 6-47 and Figure 22 of Nagasato disclose the combination of a moving magnet system and a moving coil system of claims 9 and 12. The Examiner further asserts on page 6 of the Office action, that parts 11a-d, 12a, 12b, 5a-d and 13a-d of Nagasato Figure 7 and parts 23a-d, 24a, 24b and 25a-f of Nagasato Figure 22 disclose the combination of a moving magnet system and a moving coil system of claim 15.

It was respectfully noted in the telephonic interview conducted on January 20, 2003, that Nagasato, at col. 12, ll. 36-37, discloses that the objective lens driving device 101 in the second embodiment (Figure 7) "is of a moving magnet type" and, at col. 16, ll. 44-45, discloses that the objective lens driving device in the sixth embodiment (Figure 22) "is of a moving coil type." The Examiner and SPE apparently agreed.

It was further respectfully noted in the interview that Nagasato, at col. 12, ll. 36-37, discloses that the objective lens driving device 101 in the second embodiment (Figure 7) "is of a moving magnet type" and, at col. 16, ll. 44-45, discloses that the objective lens driving device in the sixth embodiment (Figure 22) "is of a moving coil type." The Examiner and SPE apparently agreed.

It was respectfully submitted in the interview that neither the second embodiment nor the sixth embodiment disclosed in Nagasato has the combination of a moving magnet system and a moving coil system. The Examiner and SPE apparently agreed.

Furthermore, it was respectfully submitted in the interview that the Examiner's assertion requires the combination two separate embodiments disclosed in Nagasato, for which there is no motivation to combine. The Examiner and SPE apparently agreed.

Moreover, it was respectfully noted that the Examiner further asserts, in paragraph 10 at page 7 of the Office action, that Nagasato "discloses all the subject matter claimed, except for the claimed 'combination of a moving coil system and a moving magnet system'," an assertion that appears to be in agreement with the Applicant's previous remarks and in contrast to the Examiner's assertions on page 5 of the Office action that Nagasato discloses this limitation. The Examiner and SPE apparently agreed.

It is respectfully asserted that independent claims 9, 12, and 15 are allowable over the cited reference. It is further respectfully asserted that claims 10 and 11, which depend from claim 9, claims 13 and 14, which depend from claim 12, and claims 16-19, which depend from claim 15, are also allowable over the cited reference.

§ 103 Rejection

Claim 20 was rejected under 35 U.S.C. § 103(a) as being obvious over Nagasato in view of Gijzen et al. (US 4,767,187). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (Citations omitted.)

It was respectfully noted in the telephonic interview conducted on January 20, 2004, that Independent claim 20 is similar to independent claim 1, in that it also recites a lens holder mounted with a magnet and coils as well as a fixed body having a magnet and coils mounted thereon, and is similar to independent claims 9, 12 and 15, in that it also recites a combination of a moving magnet system and a moving coil system. The Examiner and SPE apparently agreed.

It was respectfully submitted in the interview that the Applicant's previous remarks, with respect to independent claim 1, that Nagasato neither discloses nor suggests a lens holder mounted with a magnet and coils as well as a fixed body having a magnet and coils mounted thereon, are applicable to the rejection of independent claim 20 since the Examiner does not

assert that Gijzen et al. discloses this limitation and, therefore, that independent claim 20 is allowable for the same reasons that independent claim 1 is allowable. The Examiner and SPE apparently agreed.

It is further respectfully noted that the Federal circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987).

The Examiner asserts, at paragraph 10 of the Office action, that Gijzen et al. discloses the "combination of a moving coil system and a moving magnet system (see column 6, lines 28-36)" that is not disclosed by Nagasato. It is respectfully submitted that neither Nagasato nor Gijzen et al. provides the requisite motivation to modify the Nagasato invention with the teachings of Gijzen et al.

It was respectfully noted in the telephonic interview conducted on January 20, 2004, that Nagasato is directed to a quadaxially-driving device that provides tracking and focusing operations as well as tilt compensating operations. The Examiner and SPE apparently agreed.

It was further respectfully noted in the interview that Gijzen et al., as disclosed at col. 2, ll. 46-57, is directed to "a '2D actuator'" that provides "[movement] about the pivotal axis for the focusing movements" and "[movement] about the pivotal axis for the purpose of radial or tangential tracking," and it was respectfully submitted that the "radial and tangential tracking" disclosed in Gijzen et al. is analogous to the radial and tangential **tilt** operation disclosed in Nagasato. The Examiner and SPE apparently agreed.

Moreover, it was respectfully noted in the interview that no **tracking** operation such as that disclosed in Nagasato is disclosed or suggested by Gijzen et al., as evidenced by Gijzen et al., at col. 5, ll. 9-14, which discloses that radial tracking is performed by "a slide of the optical disc player" rather than the actuator. The Examiner and SPE apparently agreed.

It is respectfully asserted that there is no motivation to modify the quadaxially-driving device of Nagasato with the biaxially-driving actuator of Gijzen et al. to attain the quadaxially-driving device of the present invention. Although the SPE asserted in the interview that independent claim 20 does not recite any "tracking" or "tilt" operations, it is respectfully submitted that the absence of such recitations from independent claim 20 has no bearing on the lack of motivation to combine the Nagasato and Gijzen et al. references, given that such hindsight reconstruction is not allowable.

Even if the requisite motivation is found to modify Nagasato with the teachings of Gijzen et al., the Examiner's assertion that "Gijzen et al. teaches 'replacing 'one magnet' of the frame with 'one coil' and replacing 'one coil' of the optical holder with 'one magnet'" is traversed.

It was respectfully noted in the telephonic interview conducted on January 20, 2004 that Gijzen et al. discloses, at col. 4, ll. 59-63 and col. 5, ll. 22-30, an optical holder 10 having focusing coil 14 and tracking coil 24 and magnets 16, 20 secured to the deck plate 2A1 and it was respectfully submitted that no magnets are disclosed as being on the optical holder 10, nor are any coils disclosed as being secured to the deck plate 2A1. The Examiner and SPE apparently agreed.

It was further respectfully noted in the interview that the portion of Gijzen et al. to which the Examiner refers (col. 6, ll. 28-36) states that "it is possible to replace one or more magnets of the frame by one or more suitable coils...in combination with the replacement of the coils of the optical holder by magnets" and respectfully submitted that the replacement of "*one or more coils* of the optical holder by magnets" is not disclosed. The Examiner and SPE apparently agreed.

Moreover, it was respectfully submitted in the interview that the "replacement" suggested at col. 6, ll. 28-36 of Gijzen et al. is of **all the coils of the optical holder with magnets** which would result in the optical holder 10 having *only* magnets and, therefore, would simply convert a moving coil system to a moving magnet system, not create a combination of a moving magnet system and a moving coil system. The Examiner and SPE apparently agreed.

It is respectfully asserted that the Examiner has failed to establish the requisite prima facie case of obviousness with respect to two different elements of independent claim 20. First, there is no assertion by the Examiner, nor is there any disclosure in either Nagasato or Gijzen et al., of an actuator having a lens holder mounted with a magnet and coils as well as a fixed body having a magnet and coils mounted thereon. Secondly, there is not the requisite motivation to alter the teachings of Nagasato with the teachings of Gijzen et al. nor is there the disclosure or suggestion in either reference of a combination of a moving magnet system and a moving coil system.

CONCLUSION

In light of the above remarks, applicants submit that the present Amendment places all claims of the present application in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

U.S. Patent No. 6,341,104 to Yamaguchi et al. and U.S. Patent No. 5,475,661 to Tomita et al. have been cited by the Examiner as pertinent, but not relied upon. Applicant has reviewed those references as well as the other references made of record and believes they neither anticipate nor render obvious the present invention.


No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

LEE, HONG, DEGERMAN, KANG & SCHMADEKA

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By: 

Richard C. Salfelder
Registration No. 51,127
Attorney(s) for Applicant(s)

RCS:mv

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Customer No. 035884

801 S. Figueroa Street, 14th Floor
Los Angeles, California 90017
Telephone: 213-623-2221
Facsimile: 213-623-2211